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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,281	03/12/2004	Murat Quadir	LOREAL 3.0-005 I	7212

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L'OREAL USA/ PATENT DEPARTMENT
30 TERMINAL AVENUE
CLARK, NJ 07066

EXAMINER	
RAE, CHARLESWORTH E	

ART UNIT	PAPER NUMBER
1611	

MAIL DATE	DELIVERY MODE
09/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,281	QUADIR, MURAT	
	Examiner	Art Unit	
	CHARLESWORTH RAE	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-19 and 52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-19 and 52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's arguments, filed 06/17/08, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of actions being applied to the instant application.

This action is made final. The new bases of the rejections are necessitated by the claim amendment narrowing the scope of the claims.

Status of the Claims

Claims 3-19 and 52 are currently pending in this application.

Claim Amendment

Claim 52 is new. Claims 3-4 and 8-12 have been amended to depend from claim 52.

Applicant's statement that support for the claim amendment can be found throughout the specification including, for example, para. 0014-0017, 0024-0027, 0053-0060 ... (see applicant's Response, received 06/09/08, page 5). Applicant's statement that no new matter has been added by amendment is also acknowledged.

Response to applicant's arguments/remarks

Objection to the claims

The objection is withdrawn in view of the claim amendment.

Rejection under 112, 2nd paragraph

This rejection is withdrawn in view of the claim amendment.

Rejection under 102(a)

This rejection is withdrawn in view of the claim amendment.

Rejection under 103(a)

This rejection is withdrawn in view of the claim amendment.

Nonstatutory obviousness-type double patenting (ODP) rejection

This rejection is maintained because applicant's response fails to address the merits of rejection.

Applicant statements are acknowledged with respect to the following:

1) Because the claims of the '281 application have not yet issued, this provisional rejection may never mature.

2) Should this be the sole remaining rejection and be appropriately maintained, applicant will at that time respond to the rejection, and if appropriate, offer a terminal disclaimer.

In response, this rejection is maintained.

REJECTIONS

Claim rejections – 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-19, and 52 are rejected under 103(a) as being unpatentable over Yu (US Patent Application Pub. No. 2003/0235552 A1), in view of Fukui et al. (US Patent 4,801,445), in further view of Laine et al. (US Patent 6,927,301).

Claim 3 recites "formulated in the form of a liquid, solid, cream, ointment, solution, gel, mousse, stick, cream, spray, powder, emulsion or dispersion." Claim 4 recites "wherein said at least one POSS is present in an amount of at least about 0.005% by weight of said product." Claim 5 recites "wherein said at least one POSS is present in an amount of at least about 0.01% by weight of said product."

Claim 6 recites "wherein said at least one POSS is present in an amount of at least about 0.05% by weight of said product." Claim 7 recites "wherein said at least one POSS is present in an amount of at least about 0.10% by weight of said product."

Claim 8 recites "wherein said at least one POSS is present in an amount of less than or equal to about 40% by weight of said product." Claim 9 recites "wherein said at

least one POSS is present in an amount of less than or equal to about 20% by weight of said product." Claim 10 recites "wherein said at least one POSS is present in an amount of less than or equal to about 10% by weight of said product."

Claim 11 recites "wherein said at least one personal care ingredient is an absorbent, alphahydroxy acid, betahydroxy acid, polyhydroxy acid, antiacne agent, antiperspirant, ..., solvent essential oil, sunscreen and UV-absorber, vitamin, provitamine, plant extract, ceramide and pseudoceramide."

Claim 12 recites "wherein said at least one personal care ingredient is present in I an amount of less than or equal to about 99.995% by weight of said product.

Claim 13 recites "wherein said at least one personal care ingredient is present in I an amount of less than or equal to about 99.99% by weight of said product."

Claim 14 recites "wherein said at least one personal care ingredient is present in an amount of less than or equal to-about 99.95% by weight of said product."

Claim 15 recites "wherein said at least one personal care ingredient is present in an amount of less than or equal to about 99.9% by weight of said product."

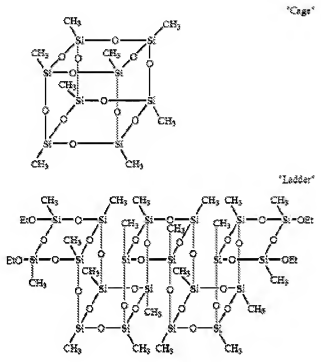
Claim 16 recites "wherein said at least one personal care ingredient is present in an amount of at least about 10% by weight of said product." Claim 17 recites "wherein said at least one personal care ingredient is present in an amount of at least about 60%

by weight of said product." Claim 18 recites "wherein said at least one personal care ingredient is present in an amount of at least about 80% by weight of said product."

Claim 19 recites "wherein said at least one personal care ingredient is present in an amount of at least about 90% by weight of said product." Claim 52 recites [a] personal care product comprising at least one POSS and at least one personal care ingredient, wherein said POSS is octa(phenyl)octasilsesquioxane and wherein said personal care product is a sunscreen composition, suntan product,antiperspirant, deodorant, cold cream, moisturizer, cleaner, …, or a hair shine product."

Yu (US Patent Application Pub. No. 2003/0235552 A1) teaches cosmetic composition for care and/or make-up and/or treatment of the skin and/or lips comprising structured silicone polymer and film-forming silicone resins, wherein the composition can exist in the form of a paste, a solid, or a viscous cream; said composition can be a simple or multiple emulsion or a rigid or supple gel with an oily continuous phase (abstract; para. 0034). Yu teaches that it is common to find a structured, that is, gelled and/or rigidified, liquid fatty phase in cosmetic and dermatological products, especially in the case of solid compositions such as deodorants, lip balms and lipsticks, eye shadow, concealers, and foundations (= personal care products) by the aid of waxes or fillers paras. 0006; 0365-0367). However, waxes and fillers have a tendency to make the composition matte, which is not always desirable, in particular for a lipstick or an eye shadow (para. 0006, last five lines). Yu teaches liquid fatty phase comprising at least one silicone oil which can be a volatile oil, a nonvolatile oil or a mixture thereof, wherein

the volatile silicone oil can be chosen from among the linear or cyclic silicone oils such as the linear or cyclic polydimethylsiloxanes (PDMS) having from 3 to 7 silicon atoms (para 0037-0044). The nonvolatile silicone oils can be polydimethylsiloxanes, polyalkylmethylsiloxanes, ..., and dilauroyltrimethyllol propane siloxysilicate, wherein the alkyl groups of these oils have in particular from 2 to 24 carbon atoms (para. 0045). Yu teaches that the structuring of the liquid fatty phase makes it possible to limit its exudation from solid compositions and, in addition, after deposition on the skin or lips, to limit migration of this phase into wrinkles and fine lines (para. 0009). Yu teaches polymers for use as gelling agents are the polyorganosiloxane type which generally represents from 0.5 to 80% of the total weight of the composition (i.e. overlaps with applicant's claimed range of 0.005% to less than or equal to 99.99%; para. 0111). Yu teaches that polymethylsilsesquioxane which can be used include the polymers taught to be in a “cage” and “ladder” configuration as shown below, including ethoxy (CH3CH2O) groups (paras. 0331 to 0334):



Yu teaches that the stick compositions impart a noteworthy elastic softness on application which is not observed with stick compositions of the prior art (para. 03555). However, Yu does not teach the instant claimed octa(phenyl)octasilsesquioxane POSS as recited in claim 52.

Fukui et al. (US Patent 4,801,445) teach cosmetic compositions containing modified powder or particulate material having a silicone polymer film coated on substantially the entire surface thereof, wherein the amount of the polymer film is 0.005% to 50% by weight based on the weight of the powder material (abstract; col 6, lines 48-56). Fukui et al. teach linear silicone compounds and cyclic silicone compounds, including dihydrogen octamethyl cyclopentasiloxane, which may be used alone or in combination thereof (col. 8, lines 38-51). Fukui et al. teach that particulate

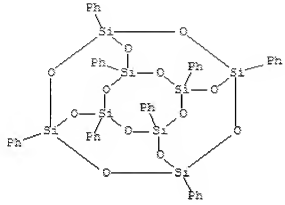
matter capable of being modified include titanium coated mica, iron oxides, titanium dioxide, titanium lower oxides, and ultramatine blue (col. 8, lines 61-68). Fukui et al. teach that mica particles, for example, are conventionally used as a filler or additive, for example, coating compositions, inks, cosmetics, as wells as plastics and rubbers (col. 11, line 36 to col. 12, line 13). Fukui et al. also teach that when modified mica is incorporated into compositions, the mica does not decompose or deteriorate co-existing substances and , therefore, the stability of cosmetics and pharmaceutical compositions are improved.

Laine et al. (US Patent 6,927,301) is added to show the general knowledge regarding the physicohemical properties of octa(phenyl)octasilsesquioxane. Laine et al. teach functionalized cage silsesquioxanes containing from 6 to 24 silicon atoms, where R is a phenyl group bearing a chemical reactive functional group, including the below compound which reads on applicants applicant's octaphenyl silsesquioxane recited in claim 52:

Pentacyclo[9.5.1.13,9.15,15.17,13]octasiloxane, 1,3,5,7,9,11,13,15-octaphenyl-

MF C48 H40 O12 Si8

CI COM



Laine et al. teach that phenyl groups serve as an admirable vehicle for functionalization by electrophilic substitution (col. 4, lines 47-50). Laine et al. teach said functionalized silsesquioxanes with wide ranging application for improved stability of products, including construction materials and photonic (col 5, line 61 to col. 6, line 10).

It would have been obvious for a person of skill in the art to add octa(phenyl)octasilsesquioxane as taught by Laine to the siloxane composition taught by Yu to improve the stability of the composition. . Although Laine et al. is not analogous art, based on the teaching of Fukui et al., the use of silicone compounds to improve cosmetic and contruction products, including plastics, is known in both the cosmetic and construction arts. Thus, one would have been motivated to add octa(phenyl)octasilsesquioxane as taught by Laine et al. to the composition taught by Yu because Fukui et al. teach linear silicone compounds and cyclic silicone compounds, including dihydrogen octamethyl cyclopentasiloxane, which may be used alone or in combination thereof in various compositions, including cosmetics, plastics,

inks, and rubbers, and Laine et al. teach functionalized cage silsesquioxanes as vehicles for a wide variety of products including construction and phototonic crystalsOne would have expected to successfully add octa(phenyl)octasilsesquioxane to the composition of Yu because the physiochemical properties of octa(phenyl)octasilsesquioxane were known in the art at the time the invention was made and the chemical structure of octa(phenyl)octa silsesquioxane as taught by Laine and the instant claimed POSS compounds are almost identical except for the R groups. Further, Yu, Fukui et al. and Laine et al. are all directed to the same concern with respect to improved silicone products.

Thus, a person of skill in the art at the time the invention was made would have found it obvious to create the instant claimed invention with reasonable predictability.

Nonstatutory Obviousness-Type Double-Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-19 and 52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of US Patent Application No. 10,799,280 (App. '280) in view of Yu (US Patent Application Pub. No. 2003/0235552 A1). The above discussion of Yu is incorporated by reference. Unlike the instant claims, the reference claims are directed to personal care products comprising EPOSS. It would have been obvious to a person of skill in the art at the time the invention was made to substitute an EPOSS as encompassed by the reference claims with a POSS as taught by Yu for use as a structuring agent. One would have been motivated to substitute an EPOSS with a POSS because Yu teaches both POSS and EPOSS as structuring

agents. Thus, a person of skill in the art at the time the invention was made would have found it obvious to create the instant claimed invention with reasonable predictable.

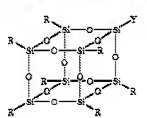
This is a provisional obviousness-type double patenting rejection because the conflicting claims of the copending applications have not in fact been patented.

Relevant Art of Record

The below cited art references made of record and relied upon are considered pertinent to applicant's invention.

Bonafini, Jr, et al. (US Patent 6586548) teach Polymeric biomaterials containing silsesquixane monomers having the below structures for preparing contact lens(see especially col. 11, lines 1-5; and claim 2):

POSS compound has the formula:



wherein:
each Y is independently an ethylenically unsaturated radical; and
each R is independently selected from the group consisting of a C_1–C_{12} monovalent hydrocarbon radical,

a C_1–C_{12} monovalent hydrocarbon radical containing ether linkages, a halogen-substituted C_1–C_{12} monovalent hydrocarbon radical, and a halogen-substituted C_1–C_{12} monovalent hydrocarbon radical containing ether linkages.

Hutchins et al. (US Patent 5,804,173) teach personal care compositions comprising a copolymer complex and a volatile, hydrophobic solvent component for

solubilizing or dispersing the copolymer complex (column 1, lines 7-9). Hutchins et al. teach the copolymer complex is formed by complexing a fatty acid with a copolymer, wherein the copolymer comprises a hydrophobic monomer, a hydrophilic monomer such that at least 1% by weight of the total copolymer, comprises hydrophilic monomers bearing nitrogen functional groups, and optionally a hydrophobic macromonomer (column 1, lines 9-15). Hutchins et al. teach that the compositions of the invention provide improved delivery, deposition and retention to the hair and skin (column 1, lines 15-16). Hutchins et al. also teach that the copolymers of the invention can be formulated into a wide variety of product types, including mousses, gels, lotions, creams, ointments, tonics, sprays, aerosols, shampoos, conditioners, rinses, bar soaps, hand and body lotions, mascaras, antiperspirants, deodorants and the like (column 15, line 48 to column 20, line 67).

Roulier et al. (US Patent 6,045,814) teach cosmetics of rigid gels containing at least 20% by weight of one or more water-soluble or hydrophilic gelling agent, wherein the composition may be in the form of a stick, a pencil or cake,, lipsticks, foundations, eyeshadows, depigmenting, make-up removing or moisturizing sticks, deodorant sticks (abstract; col. 1, lines 5-64). Roulier et al. teach compositions comprising one or more silicone gums which allow qualities of softness and slippery fell to be imparted to the final compositions and which are generally difficult to incorporate homogenously at the same time into the anhydrous phases and into the aqueous phases, wherein the silicone gum have a molecular weight of less than 1,500,000, such as

polydimethylsiloxnae, a polyphenylsiloxane or a polyhydroxysiloxane (col. 6, lines 55-65).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau, can be reached at 571-272-0614. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http:pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8 September 2008
/C. R./
Examiner, Art Unit 1611

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611